



Patent
Attorney's Docket No. 033123-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Patent Application of)
U.S. Patent No. 5,171,671)
)
Ronald M. EVANS et al) Group Art Unit: 1646
)
Application No.: 09/773,042) Examiner: Unassigned
)
Filed: January 31, 2001)
)
For: RETINOIC ACID RECEPTOR)
COMPOSITION)

DECLARATION UNDER 37 C.F.R. §1.175

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Petitioner, through the undersigned, declares that Petitioner is a not-for-profit corporation existing under the laws of California, having a place of business in La Jolla, California, and is the owner of the entire right, title and interest in and to United States Letters Patent No. 5,171,671, granted December 15, 1992, and entitled "RETINOIC ACID RECEPTOR COMPOSITION."

Petitioner further declares the following:

The present reissue is filed based upon Petitioner's belief that United States Letters Patent No. 5,171,671 may be at least partially inoperative or invalid for the reason that

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Petitioner inadvertently recited that the DNA encoding retinoic acid receptor protein hybridized to the DNAs recited in certain claims of the '671 patent. Instead, the DNA encoding retinoic acid receptor protein hybridizes to the complementary strand of the DNAs recited in claims 1, 2, 4, 5 and 7, as issued, wherein said hybridizing DNA encodes retinoic acid receptor protein. This error in claiming was brought to Petitioner's attention during Interference No. 104,583.

This application for reissue of the original Letters Patent addresses the aforementioned error in claiming by amending claims 9 and 11-14 as issued to recite that the DNA hybridizes to the complementary strand of the DNA recited in the prior claims. The amended claims are fully supported by the specification. One skilled in the art reading the specification of the '671 Patent would recognize that the claimed DNA could not hybridize to DNA encoding RAR and itself encode RAR. Instead, one skilled in the art would recognize that the DNA encoding RAR would hybridize to the complementary strand of the DNA recited in the prior claims. The amended claims are thus fully supported by the specification.

The aforementioned error in claiming occurred without any deceptive intention on Petitioner's part. On information and belief, all errors being corrected in the Reissue Patent Application arose without any deceptive intention on the part of the applicant.

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Petitioner verily believes that the named inventors, Ronald M. Evans, residing at 1471 Cottontail Lane, La Jolla, CA 92037, a citizen of the United States; Estelita S. Ong, residing at 6307 Hannon Ct., San Diego, CA 92117, a citizen of the United States; Prudimar S. Segui, residing at 10833 NE 149th St., Bothell, WA 98011, a citizen of the United States; Catherine C. Thompson, residing at 503 Wingate Rd., Baltimore, MD 21210, a citizen of the United States; Kazuhiko Uemsono, now deceased; and Vincent Giguere, residing at 277 Querbes, Outremont, H2V 3W1 Canada, a citizen of Canada; to be the first, original and joint inventors of the subject matter which is described and claimed in the specification and claims of the present Reissue Patent Application. Petitioner does not believe that the invention was ever known or used before the above-named inventors' invention thereof was made.

Petitioner has reviewed and understands the contents of the specification, including the claims as presented in the instant application for reissue.

Petitioner acknowledges the duty to disclose information of which Petitioner is aware and which is material to the examination of this application for reissue, in accordance with 37 C.F.R. § 1.56(a).

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The undersigned hereby declares further that all statements made herein of his own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

THE SALK INSTITUTE FOR BIOLOGICAL STUDIES

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